



# Justice Ruth Bader Ginsburg's Lasting Impact on Intellectual Property Law

Author(s): Holly Pekowsky ,

There is no doubt that the U.S. Supreme Court Justice Ruth Bader Ginsburg leaves behind a legacy as a legal trailblazer, paving the way for gender equality and women's rights. However, not to go unnoticed is her impact on intellectual property law.

A look at some of her most notable opinions in intellectual property law shows her influence throughout her career on copyright, patent and trademark law.

## Copyright Law

Throughout her career, Justice Ginsburg penned numerous opinions and dissents involving intellectual property law. However, perhaps Justice Ginsburg's most notable contributions to intellectual property centered around copyright law.

Justice Ginsburg helped to set the basis for who can sue for copyright infringement, and when. Recently, she authored the unanimous decision in *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC*, 139 S. Ct. 881 (2019), which held that copyright registration only occurs once the copyright is successfully registered by the United States Copyright Office. Only after successful registration may a copyright claimant bring an infringement action.

Further, in leading the majority in *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 572 U.S. 663 (2014), Justice Ginsburg concluded that laches could not preclude a creator from pursuing a copyright infringement claim if brought within the three-year statutory limitation period of the Copyright Act. She reasoned that "if the rule were ... 'sue soon, or forever hold your peace,' copyright owners would have to mount a federal case fast to stop seemingly innocuous infringements, lest those infringements eventually grow in magnitude."

Recognizing the value of a copyright to a creator, she continuously sought to strengthen the rights and protections afforded to authors under copyrights.

Justice Ginsburg's most significant opinion was in *Eldred v. Ashcroft*, 537 U.S. 186 (2003), where she upheld the constitutionality of the Copyright Term Extension Act, extending the



duration of copyrights for 20 years beyond what had previously been allowed. Reasoning that the Act's term was limited, not perpetual, she concluded that the Act was valid as Congress acted within the "limited times" constraint of the U.S. Constitution's Copyright Clause.

In addition, Justice Ginsburg in *New York Times Co. v. Tasini*, 533 U.S. 483 (2001) upheld protections for freelance authors by holding that publishers could not reproduce those authors' individual works in databases without permission, as doing so would infringe the authors' copyright.

## Patent Law

Justice Ginsburg's opinions on patent law tended to favor patent challengers, and not patentees.

In her opinion in *Thryv, Inc. v. Click-to Call Techs. LP*, 140 S. Ct. 1367 (2020), Justice Ginsburg reinforced the non-appealability of PTAB institution decisions. In holding that the PTAB's decision to institute IPR proceedings cannot be appealed, even if based on a timeliness objection, her decision will further limit future attacks on PTAB decisions.

In the unanimous decision *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898 (2014), Justice Ginsburg, in writing for the majority, lowered the requirement to establish indefiniteness of a patent claim by replacing the Federal Circuit's "insolubly ambiguous" standard with a "reasonable certainty test." Under the new standard, "a patent is invalid for indefiniteness if its claims, read in light of the specification and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention."

Further, in her first of only two authored dissents relating to patent law, Justice Ginsburg dissented in part from the majority opinion in *Impression Prods. v. Lexmark Int'l, Inc.*, 137 S. Ct. 1523 (2017), which held that an authorized sale outside of the United States, just as one within the United States, exhausted all rights under the Patent Act. Justice Ginsburg reasoned that "[b]ecause a sale abroad operations independently of the U.S. patent system," (i.e., U.S. patent protection does not attach to a U.S. patentee's sales abroad), "it makes little sense to say that such a sale exhausts an inventor's U.S. patent rights."

## Trademark Law

While Justice Ginsburg infrequently wrote on trademark law, she recently authored the groundbreaking majority opinion in *USPTO v. Booking.com B.V.*, 140 S. Ct. 2298 (2020), holding that Booking.com could register its name as a trademark. In rejecting the USPTO's nearly per se rule against trademark protection for a "generic.com" term, Ginsburg expanded



trademark protection for companies who previously could not register their mark.

## Conclusion

While these opinions are only a select handful of those Justice Ginsburg wrote, they epitomize her judicial philosophy with respect to intellectual property law. In these uncertain times, we will see how her absence on the Court will impact future developments in intellectual property law. May she rest in peace.

*\*[Holly Pekowsky](#) is a partner and [Chandler Sturm](#) are associates at Amster, Rothstein & Ebenstein LLP. Their practice specializes in intellectual property issues, including litigating patent, trademark and other intellectual property disputes. They can be reached at [hpekowsky@arelaw.com](mailto:hpekowsky@arelaw.com) and [csturm@arelaw.com](mailto:csturm@arelaw.com).*